REMARKS/ARGUMENTS

In the Office action dated March 19, 2004, the examiner rejected claims 6, 11, and 17 under 35 U.S.C. 112, second paragraph. In response, independent claims 1, 7, 13 and 23 have been amended to state that the layers formed over the core of a lithiated compound are "metal or metalloid oxide layers." The dependent claims have been similarly amended as necessary to correspond to the amended language of the independent claims. Based on these amendments, applicant requests the withdrawal of the rejection under Section 112.

The examiner further rejected claims 1-4 and 6-11 under 35 U.S.C. 103(a) based on Amatucci et al. According to the examiner, Amatucci teaches a current collector comprising a lithiated compound coated with a single layer of aluminum oxide. The examiner recognizes that Amatucci fails to teach the inclusion of two layers over the lithiated compound, but without citing any further references, asserts that it would have been obvious to one of ordinary skill in the art to apply an additional metal oxide layer. Applicant submits that such hindsight analysis is improper, and requests that the examiner reconsider this basis for rejecting the subject claims.

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See MPEP 2143.03 and *In re Royka*, 490 F.2d 981 (CCPA 1974). In addressing obviousness, we are warned against entering the "tempting but forbidden zone of hindsight." *In re Dembiczak*, 50 U.S.P.Q. 2d 1614, 1616 (Fed. Cir. 1999). In condemning the "hindsight" approach, the Federal Circuit has pointed out that "Measuring a claimed invention against the standard established by Section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *Id.* at 1617.

In the present application, the only suggestion that two layers might be better than one is the patent specification itself. No reference teaching such a modification to the prior art has been cited. Consequently, because the cited references fail to teach or suggest the claimed combination, rejection under Section 103(a) is improper.

In addition, claims 1, 2, 6-8, 11, 13, 14, 17, 19, 20 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Lee. Similarly, claims 1, 3, 4, 6, 7, 9-11, 13, 15-19, 20 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Zhang, and claims 23-28 were rejected under 35 U.S.C. 103(a) as unpatentable over Zhang in view of Amatucci. In so rejecting the claims, the examiner again admits that Lee, Zhang, and Amatucci are all silent as to the use of

two coating layers. However, as pointed out above, absent some teaching or suggestion in the prior art that two layers may be used, an assertion that two layers would have been obvious is an improper hindsight analysis, and for this reason alone, the subject claims are allowable.

To further distinguish the invention, it is noted that the coating materials disclosed by both Lee and Zhang are lithiated compounds. See Lee, paragraphs 10, 11 and 32, and Zhang, paragraphs 10, 18 and 19. Applicant has amended independent claims 1, 7, 13 and 23 to specifically recite that the oxides used to form the layers on the positive active material are *non-lithiated.* Such a limitation is inherent to the specification as filed as none of the examples set forth in the specification discloses the use of a lithiated oxide, nor does the specification as filed suggest that the oxides be lithiated. Consequently, the invention is neither taught nor suggested by the cited references. Applicant requests that the rejections be withdrawn so that the claims may proceed to allowance.

Claims 1-4, 6-11, 13-20 and 22-28 remain pending in this application. For the reasons set forth above, applicant submits that all claims are in condition for allowance. However, if the examiner has any further questions regarding this application, she is asked to contact counsel at the number below.

Respectfully submitted,

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